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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,199	04/14/2004	Jonathan Willinger	JWIL 20.354 (100668-00107)	5866
26304	7590	05/23/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			NGUYEN, TRINH T	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,199	<b>Applicant(s)</b> WILLINGER ET AL.	
	<b>Examiner</b> Trinh T. Nguyen	<b>Art Unit</b> 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on RCE dated 5/12/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination under 37 CFR 1.114 After Final Rejection***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/06 as been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, 8, 12-16, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Iacovelli et al. (US 6,794,013).

For claims 1 and 14 and 20, Iacovelli et al. disclose a mat comprising: a planar upper surface; a plurality of raised bumps (18,48,44,28,24,46) arranged in a contiguous field on said upper surface in an irregular, asymmetric pattern; a peripheral edge (30); and wherein said plurality of bumps are sized and spaced such that when the bowl is placed anywhere in the contiguous field, the bowl normally falls within interstices of the bumps and is restrained by said bumps in a plurality of non-dedicated locations; a bottom surface resisting sliding with respect to a support surface.

For claim 3, Iacovelli et al. disclose the raised peripheral edge has an irregular shape.

For claims 4 and 15, Iacovelli et al. disclose the raised peripheral edge has a shape that, when viewed from the top of the pet mat, is partially curved and partially straight.

For claims 5 and 16, Iacovelli et al. disclose the plurality of bumps further comprises a series of bumps (18,48,44,28,24,46) spaced from the raised peripheral edge to prevent a bowl placed on said upper surface from moving toward said raised peripheral edge.

For claims 8 and 18, Iacovelli et al. disclose the upper surface further comprises a decorative image (note that the arrangement of portions 18,48,44,28,24,46 formed a decorative image) and wherein said raised peripheral edge has a shape that is similar to a portion, but not the entirety, of said decorative image.

For claim 12, Iacovelli et al. disclose at least one bowl placement locator (48) formed on said upper surface.

For claim 13, Iacovelli et al. disclose at least one bowl placement locator is part of an ornamental design embossed or imprinted on said upper surface.

It is noted that Iacovelli et al.'s mat is capable of being used as a pet mat since Iacovelli et al.'s mat comprises the satisfying structural members that can be used by a pet. Further, note that it is well settled case law that such limitations, which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See In re

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Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647; and MPEP 2114 & 2115.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 7, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli et al. (US 6,794,013) in view of Lampe (US 5,743,210).

As described above, Iacovelli et al. disclose most of the claimed invention except for indicating that the mat is made from a non-stick, tacky material wherein the tacky material is natural rubber.

Lampe teaches the concept of using a non-stick, tacky pad/material (70), wherein the tacky pad/material is made from a rubber-like material, on the bottom of a structural member (22) so as to prevent the structural member from sliding about. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mat of Iacovelli et al. so as to include the use of a non-stick, tacky pad/material on the bottom of the mat, in a similar manner as taught in Lampe, in order to prevent the mat from sliding about. Regarding the tacky material is natural rubber, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Also, since applicant did not provide a reason and/or showing any criticality as to why the material has to be natural rubber, it is believe that through trial and error during the manufacturing process that one comes up with the most efficient material to meet the design criteria (see page 3 of the specification, Applicant only stated that "The pet mat 10 of the present embodiment is preferably formed from a non-stick, tacky material, such as natural rubber").

6. Claims 9-11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli et al. (US 6,794,013).

As described above, Iacovelli et al. disclose most of the claimed invention except for indicating that the decorative image has a specific shape (i.e. the decorative image is a pair of paw prints which is defined by a plurality of oval digits and a circular palm portion). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the mat of Iacovelli et al. in whatever form or shape was desired or expedient, wherein applicant did not provide a reason or a stated problem is solved by having the specific shape as claimed versus the shape taught by the prior art. Note that a change in form or shape is generally recognized as being well known within the level to one of ordinary skill in the art depending on one's intended use. Furthermore, note that in lines 15 and 16 of page 3 of the specification, applicant stated that "although other ornamental designs are contemplated"; therefore, it is believe that through trial and error in the manufacturing procedure that one comes up

with a particular shape to meet the require design criteria for manufacturing of a pet mat.

***Response to Arguments***

7. Applicant's arguments filed 3/21/06 have been fully considered but they are not persuasive.

8. In response to applicant's argument that lacovelli's peripheral edge does not bound the contiguous field of a bump, the Examiner disagrees. It is noted that *The American Heritage Dictionary of the English Language, Fourth Edition* copyright © 2000 by Houghton Mifflin Company (on line version at Dictionary.com) defines the term "contiguous" as "sharing an edge or boundary; touching" or "neighboring; adjacent". Therefore, as broadly claimed and a fair reading of the claim language permits the Examiner to interpret that lacovelli's bumps (18,48,44,28,24,46) are arranged in a contiguous filed on the upper surface and that peripheral edge (30) does bound the contiguous field of the bumps (see Figure 1 of lacovelli).

9. In response to applicant's argument that lacovelli teaches away from the claimed pet mat and that lacovelli's mat is a vehicle floor mat. The Examiner agrees that lacovelli's mat is a vehicle floor mat, however, it is noted that lacovelli et al.'s mat is capable of being used as a pet mat since lacovelli et al.'s mat comprises the satisfying structural members that can be used by a pet. Further, note that it is well settled case law that such limitations, which are essentially method limitations or statements or intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ

705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647; and MPEP 2114 & 2115.

10. In response to applicant's argument that Iacovelli teaches that a bowl can only be placed in the area 42 and then only in a limited way, the Examiner disagrees. It is noted that a bowl can be made from various sizes and shapes; therefore, one can have a bowl that is sized and shaped in a desirable size and/or shape in order to place onto any desirable area.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M). The examiner's supervisor, Teri Luu can be reached on (571) 272-7045 for the purpose of status inquiry only. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A handwritten signature in black ink, consisting of a large, stylized capital 'T' followed by a horizontal line that tapers to the right.

Trinh T. Nguyen  
Primary Examiner  
Art Unit 3644

5/15/06

Fig. 1



